

### **REMARK/ARGUMENTS**

Claims 1-2 and 4-20 are pending in this application. By this amendment, Applicant amends claims 1 and 11, and cancels claim 12. In addition, Applicant adds new claims 21-24. Support for the amendments is found in the specification. No new matter is added. Reconsideration of claims 1-2, 4-11 and 13-20, as well as consideration of claims 21-24, is respectfully requested. Applicant has carefully reviewed the Office Action and feels the case is in condition for allowance in view of the amendments and remarks made below.

### **CLAIM OBJECTIONS**

Claim 12 is objected to under 37 C.F.R. § 1.75(c) as being of improper dependent form. Applicant cancels claim 12 obviating the objection with respect to claim 12.

### **CLAIM REJECTIONS UNDER 35 U.S.C. § 102**

Claims 1-2, 4, 7, 8, 11, 15 and 18-20 are rejected under 35 U.S.C. § 102(e) as being anticipated by *Young*. While the Examiner refers to the prior art reference as “*Young*,” the Examiner does not give the patent number of this reference. Applicant therefore assumes the Examiner is referring to U.S. Patent No. 2,549,741 to T.R. Young, entitled “Pipe Joint,” filed February 6, 1948. Applicant further assumes that while the Examiner stated the claims rejection under 35 U.S.C. § 102(e), the Examiner meant to reject the claims under 35 U.S.C. § 102(b), and will base Applicant’s remarks on these two assumptions. Applicant respectfully traverses these rejections.

The Section 102 rejection is proper only if each and every element, as set forth in the claim, is found – i.e., the prior art must teach every aspect of the claim. *See Verdegall Bros. v. Union Oil Co. of California*, 918 F.2d 628, 631 (Fed. Cir. 1987); *see also* M.P.E.P. § 2131. As set forth below, *Young* does not teach or suggest the combination recited by Applicant’s claims.

Applicant’s specification discloses an embodiment of “a slip joint adapter which is adaptable to extend or contract to various lengths and connect two pipes, whose ends are fixed in

relation to each other....” (*See* Specification, p. 6, ll. 1-2). That is to say, “an adaptor apparatus is provided that in some embodiments can be adjusted to connect pipe ends located at various lengths from each other” (*see id.* p. 2, ll. 13-15). An advantage of these embodiments is that “[t]he feature of allowing the pipe 12 to slide axially through the adapter 10 allows the slip joint adapter 10 to adapt to connecting two pipes together when the distance between the pipe ends can vary from application to application” (*see id.* p. 6, ll. 13-16).

In accordance with this feature of some of the disclosed slip joint adapter embodiments, claim 1, and its dependent claims 2, 4-10 and 21-24, recite, “a second chamber contained within the housing and configured to allow an end of a pipe to slide through it and *to provide a bridge* for material flowing from the pipe to a second pipe *when an end of the pipe does not contact an end of the second pipe*” (emphasis added). Thus, Applicant’s slip joint adapter connects a pipe to a second pipe, the ends of which do not necessarily contact each other. In fact, the slip joint adapter is specifically configured to accommodate pipe connections wherein the two pipe ends are not in contact with each other, in which case the second chamber provides a bridge to convey material flowing from the first pipe to the second pipe.

In stark contrast, *Young* is directed to a pipe joint wherein a flared end of a pipe is “wedged between and in direct contact with the coniform portion of” a hollow coupling member, or housing, “and the inner end of the flared portion of the pipe [is] forced into intimate contact with the conical end of said spigot.” (*See Young*, claim 1, col. 3, ll. 53-59.) The Examiner characterized the spigot member of *Young* as the second pipe recited in Applicant’s claim. (*See* Office Action, p. 4, l. 1.) However, under this theory the end of the pipe and the end of the second pipe would be forced into intimate contact with each other and the flared end of the pipe wedged between the second pipe and the tapered portion of the housing. Once again, Applicant’s claim recites two noncontacting pipe ends. *Young* discloses two pipe ends in contact each other. Thus, *Young* does not teach or suggest the elements of Applicant’s independent claim 1 and its dependent claims.

Moreover, *Young* explicitly and repeatedly teaches away from joining two pipes that are not in contact. For example, *Young* discloses that “the flared pipe end is *engaged* with the tapered portion of the coupling member or nut to press the flared pipe end upon the spigot” (*see Young*, col. 1, ll. 34-37, emphasis added), “to force the narrower end of the conically flared pipe end into *fluid tight contact* with the spigot” (*see id.* col. 1, ll. 46-48, emphasis added). Similarly, *Young* discloses that “the pipe 11 is flared at 13 to fit the conically tapered external surface 14 of the spigot member 12” (*see id.* col. 2, ll. 31-33), and that “the flared pipe end is *fitted over* the spigot member” (*see id.* col. 2, ll. 45-47). Nowhere does *Young* teach or suggest two pipe ends that are not in contact with each other.

Furthermore, *Young* does not teach or suggest a second chamber configured to provide a bridge for material flowing from the pipe to a second pipe when an end of the pipe does not contact an end of the second pipe, as recited in Applicant’s claim 1. The Examiner characterized reference numeral 17 of *Young* as the second chamber. (*See Office Action*, p. 2, l. 20.) However, reference numeral 17 of *Young* is not the second chamber recited by Applicant’s claim. Instead, reference numeral 17 is an annular groove in which a split ring 18 sits. (*See Young*, FIG. 4 and col. 3, ll. 16,-31.)

The groove 17 of *Young* is not configured to provide a bridge for material flowing from the pipe to a second pipe when an end of the pipe does not contact the end of the second pipe. On the contrary, the split ring in groove 17 is designed to hinder movement of material (*see id.* col. 3, ll. 23-25). In fact, the pipe joint disclosed in *Young* conveys material from the pipe to the spigot by way of the “fluid tight contact” between the pipe and the spigot. (*See id.* col. 1, ll. 46-48.) Thus, there is no teaching or suggestion in *Young* that material is bridged from one pipe to the other through a second chamber.

Thus, *Young* does not teach every aspect of Applicant’s independent claim 1 and its dependent claims 2, 4-10 and 21-24, because *Young* does not include each and every element, as set forth in Applicant’s claim. At least for these reasons, Applicant respectfully requests that the

rejections under Section 102 be removed with respect to claim 1 and its dependent claims 2 and 4-10.

With respect to independent claim 11, and its dependent claims 13-17, *Young* does not teach or suggest a combination recited by claim 11 and its dependent claims. For example, claim 11, and its dependent claims, recite in part, “means for *bridging fluid* flowing from the pipe to the second pipe *when an end of the pipe does not contact an end of the second pipe*” (emphasis added). Thus, Applicant’s slip joint adapter connects a pipe to a second pipe, the ends of which do not necessarily contact each other. In fact, the slip joint adapter is specifically configured to accommodate pipe connections wherein the two pipe ends are not in contact with each other, in which case the means for bridging conveys fluid flowing from the first pipe to the second pipe.

As explained above, *Young* is directed to a pipe joint wherein a flared end of a pipe is “wedged between and in direct contact with the coniform portion of” a hollow coupling member, or housing, “and the inner end of the flared portion of the pipe [is] forced into intimate contact with the conical end of said spigot.” (See *Young*, claim 1, col. 3, ll. 53-59.) Once again, Applicant’s claim recites two noncontacting pipe ends. *Young* discloses two pipe ends in contact each other.

Furthermore, the Examiner asserted that *Young* teaches the means for bridging quoted above, as indicated by item 17 in FIG. 4 of *Young*. (See Office Action, p. 3, l. 16.) However, as stated above, item 17 is an annular groove and does not provide means for bridging fluid flowing from a pipe to a second pipe when an end of the pipe does not contact an end of the second pipe. Thus, *Young* does not teach every aspect of Applicant’s independent claim 11 and its dependent claims 13-17, because *Young* does not include each and every element, as set forth in Applicant’s claim. Therefore, Applicant respectfully requests that the rejections of claims 11 and 13-17 be removed under 35 U.S.C. § 102 as being anticipated by *Young*.

With respect to independent claim 18 and its dependent claims 19-20, *Young* does not teach or suggest a method including “bridging material carried by the pipe with the slip joint adapter between two non-contacting pipe ends,” as recited by Applicant’s claim. As explained above, *Young* is directed to a pipe joint wherein a flared end of a pipe is “wedged between and in direct contact with the coniform portion of” a hollow coupling member, or housing, “and the inner end of the flared portion of the pipe [is] forced into intimate contact with the conical end of said spigot.” (See *Young*, claim 1, col. 3, ll. 53-59.) Once again, Applicant’s claim recites two noncontacting pipe ends. *Young* discloses two pipe ends in contact each other.

Furthermore, the Examiner asserted that *Young* teaches bridging material carried by the pipe with the slip joint adapter between two noncontacting pipe ends, as indicated by item 18 of *Young*. (See Office Action, p. 4, ll. 11-12.) However, as stated above, item 18 is a split ring in an annular groove and does not provide means for bridging fluid flowing from a pipe to a second pipe when an end of the pipe does not contact an end of the second pipe. Thus, *Young* does not teach every aspect of Applicant’s independent claim 18 and its dependent claims 19-20, because *Young* does not include each and every element, as set forth in Applicant’s claim. Therefore, Applicant respectfully requests that the rejections of claims 18-20, under 35 U.S.C. § 102 in view of *Young*, be removed.

#### CLAIM REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-2, 4-7 and 9-14 and 16-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Rubin, et al.* in view of *Hampe, et al.* Applicant respectfully traverses these rejections.

To establish a *prima facie* case of obviousness, three basic criteria must be met: first, there must be some suggestion or motivation, either in the references, themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; finally,

the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *See* M.P.E.P. § 2142.

As explained above, Applicant's specification discloses an embodiment of "a slip joint adapter which is adaptable to extend or contract to various lengths and connect two pipes, whose ends are fixed in relation to each other...." (*See* Specification, p. 6, ll. 1-2). That is to say, "an adaptor apparatus is provided that in some embodiments can be adjusted to connect pipe ends located at various lengths from each other" (*see id.* p. 2, ll. 13-15). An advantage of these embodiments is that "[t]he feature of allowing the pipe 12 to slide axially through the adapter 10 allows the slip joint adapter 10 to adapt to connecting two pipes together when the distance between the pipe ends can vary from application to application" (*see id.* p. 6, ll. 13-16).

In accordance with this feature of some of the disclosed slip joint adapter embodiments, claim 1, and its dependent claims 2, 4-10 and 21-24, recite, "a second chamber contained within the housing and configured to allow an end of a pipe to slide through it and *to provide a bridge* for material flowing from the pipe to a second pipe *when an end of the pipe does not contact an end of the second pipe*" (emphasis added). Thus, Applicant's slip joint adapter connects a pipe to a second pipe, the ends of which do not necessarily contact each other. In fact, the slip joint adapter is specifically configured to accommodate pipe connections wherein the two pipe ends are not in contact with each other, in which case the second chamber provides a bridge to convey material flowing from the first pipe to the second pipe.

With respect to claims 1-2, 4-7 and 9-10, *Rubin, et al.* in view of *Hampe, et al.* does not teach or suggest the combination recited by the claims. Instead, *Rubin, et al.* is directed to a universal oxygen connector system wherein "the first input end mak[es] a flush abutment with the first source of oxygen at the output orifice" (*see Rubin, et al.*, claim 1, col. 6, ll. 64-66), or in an alternative embodiment "an output end of a reduced diameter with an axial bore [is] adapted to couple within the first input end of [a] tube" (*see id.*, claim 4, col. 8, ll. 36-38). The Examiner appears to equate the output orifice 14 of *Rubin, et al.* to the second pipe of Applicant's claim.

However, as shown in FIG. 4 of *Rubin, et al.*, the pipe 24 contacts the output orifice 14, because the first input end 26 (see FIG. 2) of the pipe 24 “is adapted to make a flush abutment with the first source of oxygen at the output orifice” 14. (See *id.*, col. 4, ll. 52-54.)

In an alternative embodiment, the Examiner appears to equate the output end 80 of the second source 78 of oxygen, shown in FIG. 5 of *Rubin, et al.*, to the second pipe of Applicant’s claim. However, once again, the pipe contacts the output end 80, because the “output end is adapted to couple through simple insertion into the first input end of the oxygen tube to thereby allow the oxygen to pass from the source to the tube.” (See *Rubin, et al.*, col. 5, ll. 53-55.) As explained above, Applicant’s claim recites two noncontacting pipe ends. *Rubin, et al.* discloses two pipe ends in contact each other. Nowhere does *Rubin, et al.* teach or suggest two pipe ends that are not in contact with each other. Moreover, *Rubin, et al.* explicitly and repeatedly teaches away from joining two pipes that are not in contact by discussing a flush abutment between the two pipes (see *Rubin, et al.*, col. 4, ll. 52-54) or an alternative configuration wherein one pipe is inserted into the end of the other pipe (see *id.*, col. 4, ll. 52-54).

Furthermore, *Rubin, et al.* does not teach or suggest a second chamber configured to provide a bridge for material flowing from the pipe to a second pipe when an end of the pipe does not contact an end of the second pipe, as recited in Applicant’s claim 1. The Examiner characterizes the “longitudinal interior surface between threads and taper” (see Office Action, p. 5, l. 4) as the second chamber of Applicant’s claim. However, the longitudinal interior surface between threads and taper is not the second chamber recited by Applicant’s claim, because the longitudinal interior surface between threads and taper is not configured to provide a bridge for material flowing from the pipe to a second pipe when an end of the pipe does not contact the end of the second pipe. There is no teaching or suggestion in *Rubin, et al.* that material is bridged from one pipe to the other through a second chamber. Thus, *Rubin, et al.* in view of *Hampe, et al.* does not teach or suggest all of the claim limitations of Applicant’s independent claim 11 and its dependent claims 2, 4-10 and 21-24, because the prior art references do not include each and

every element, as set forth in Applicant's claim. Therefore, at least for these reasons Applicant respectfully requests the Examiner to remove the rejections of claims 1, 2, 4-7, 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over *Rubin, et al.* in view of *Hampe, et al.*

With respect to independent claim 11 and its dependent claims 13-14 and 16-17, the prior art references cited do not teach or suggest the combination recited in the claims. For example, claim 11, and its dependent claims, recite in part, "means for *bridging fluid* flowing from the pipe to the second pipe *when an end of the pipe does not contact an end of the second pipe*" (emphasis added). Thus, Applicant's slip joint adapter connects a pipe to a second pipe, the ends of which do not necessarily contact each other. In fact, the slip joint adapter is specifically configured to accommodate pipe connections wherein the two pipe ends are not in contact with each other, in which case the means for bridging conveys fluid flowing from the first pipe to the second pipe.

As described above, *Rubin, et al.* uses two pipe ends abutted to each other, or alternatively, one pipe inserted into the other. Thus, *Rubin, et al.* teaches away from the apparatus described in independent claim 11 and its dependent claims. Furthermore, *Rubin, et al.* in view of *Hampe, et al.* do not teach or suggest any means for bridging fluid flowing from the pipe to second pipe when an end of the pipe does not contact an end of the second pipe. Therefore, Applicant respectfully requests that the Examiner remove the rejections of independent claim 11 and its dependent claims 13-14 and 16-17 under 35 U.S.C. § 103(a) as being unpatentable over *Rubin, et al.* in view of *Hampe, et al.*

With respect to independent claim 18 and its dependent claim 19, the prior art references do not teach or suggest a method as recited by these claims. For example, claim 18 recites, a method including "bridging material carried by the pipe with a slip joint adaptor between two non-contacting pipe ends." As described above, *Rubin, et al.* teaches two pipe ends in direct abutment with each other, or alternatively, one pipe fitting inside the other. Furthermore, the prior art references do not teach or suggest any means for bridging fluid flowing from the pipe to



second pipe when an end of the pipe does not contact an end of the second pipe. Thus, *Rubin, et al.* in view of *Hampe, et al.* teaches away from using the adaptor, itself, to bridge the material carried between the two pipes. Therefore, Applicant respectfully requests that the Examiner remove the rejections of independent claim 18 and its dependent claim 19 under 35 U.S.C. § 103(a) as being unpatentable over *Rubin, et al.* in view of *Hampe, et al.*

#### CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests the objections and rejections be removed and the pending claims allowed. If, for any reason, the Examiner disagrees, please call the undersigned attorney at 202-861-1567 in an effort to resolve any matter still outstanding before issuing another action. The undersigned attorney is confident that any issue which might remain can readily be worked out by telephone.

In the event this paper is not time filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036.

Respectfully submitted,

BAKER & HOSTETLER LLP



Dana L. Christensen  
Registration No. 54,035

Date: 14 March 2005  
Washington Square, Suite 1100  
1050 Connecticut Avenue, N.W.  
Washington, D.C. 20036-5304  
Telephone: 202-861-1500  
Facsimile: 202-861-1783